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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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10/588,621

08/04/2006

Clifford Jones

101361-1P US

8249

44992 7590 11/23/2007  
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EXAMINER

KIFLE, BRUCK

ART UNIT

PAPER NUMBER

1624

MAIL DATE

DELIVERY MODE

11/23/2007

PAPER

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

<b>Office Action Summary</b>	<b>Application No.</b> 10/588,621	<b>Applicant(s)</b> JONES ET AL.	
	<b>Examiner</b> Bruck Kifle	<b>Art Unit</b> 1624	

**-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --**

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 04 August 2006.
- 2a) ☐ This action is **FINAL**.                      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-5 and 9-11 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-5 and 9-11 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All    b) ☐ Some \*    c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☒ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- |  |   |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)                     | 4) <input type="checkbox"/> Interview Summary (PTO-413)           |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____                                      |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)          | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date _____  | 6) <input type="checkbox"/> Other: _____                          |

***Claim Rejections - 35 USC § 112***

Claims 1-5 and 9-11 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. The last phrase of the claims read “and salts or solvates thereof.” This is not proper Markush language. Applicants intention also appears to have pharmaceutically acceptable salts of the compounds and not any salts, including toxic ones. It is suggested to rewrite this phrase as, for example, “or a pharmaceutically acceptable salt thereof.”

Claims 1-5 and 9-11 are rejected under 35 U.S.C. 112, first paragraph, because the specification, while being enabling for a pharmaceutical salt, does not reasonably provide enablement for hydrates or solvates of the compound of formula I. The specification does not enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make the invention commensurate in scope with these claims. Applicants have not shown how one skilled in the art can arrive at a given solvate or hydrate. None of the compounds made are crystallized out as solvates or hydrates. Arriving at a given solvate is not routine experimentation because it is unpredictable. One cannot make any solvate or hydrate of a compound.

Claims 10 and 11 are rejected under 35 U.S.C. 112, first paragraph, because the specification does not reasonably provide enablement for inhibiting Tie2 receptor tyrosine kinase activity in a warm-blooded animal or for producing an anti-angiogenic effect in a warm-blooded animal.

Claims 10 and 11 read on treating a disease or condition, which has not been specified. The how to use portion of the statute has not been addressed. This means that Applicants must teach the skilled practitioner, in this case a physician, how to treat a given subject. The physician clearly must know what diseases and what symptoms are to be treated.

Is extensive experimentation required on the part of a potential infringer to determine if his use of Applicants' agonists falls within the limitations of applicants' claim? *In re Kirk and Petrow*, 153 USPQ 48 (CCPA 1967). As the Supreme Court said in *Brenner v. Manson*, 148 USPQ at 696: "a patent is not a hunting license. It is not a reward for the search, but compensation for its successful conclusion." As U.S. Court of Customs and Patent Appeals stated *In re Diedrich* 138 USPQ at 130, quoting with approval from the decision of the board: "We do not believe that it was the intention of the statutes to require the Patent Office, the courts, or the public to play the sort of guessing game that might be involved if an applicant could satisfy the requirements of the statutes by indicating the usefulness of a claimed compound in terms of possible use so general as to be meaningless and then, after his research or that of his competitors has definitely ascertained an actual use for the compound, adducing evidence intended to show that a particular specific use would have been obvious to men skilled in the particular art to which this use relates."

Applicants have not demonstrated nor have they alleged there is any correlation between the *in vitro* assays they disclose in pages 15-20 and clinical efficacy against any disease. Case law is clear on this point. In an unpredictable art, such as CNS disease therapy, *in vitro* assays may be used for enablement only if there is a well-established correlation between the assay and clinical efficacy.

Art Unit: 1624

The specification does not enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to use the invention commensurate in scope with these claims.

The how to use requirement of the enablement statute, when applied to method claim, refers to operability and how to make the claimed method work “The factors to be considered (in making an enablement rejection) have been summarized as the quantity of experimentation necessary, the amount of direction or guidance presented, the presence or absence of working examples, the nature of the invention, the state of the prior art, the relative skill of those in that art, the predictability or unpredictability of the art and the breadth of the claims”, In re Rainer 146 USPQ 218 (1965); In re Colianni, 195 USPQ 150, Ex parte Formal, 230 USPQ 546. The issue is the correlation between clinical efficacy for producing an anti-angiogenic effect and Applicants' in vitro assay.

a) Determining if any particular claimed compound would produce an anti-angiogenic effect generally would require synthesis of the compound, formulation into a suitable dosage form, and subjecting it to clinical trials with a number of fundamentally different diseases, or to testing them in an assay known to be correlated to clinical efficacy of such treatment. This is a large degree of experimentation.

b) The direction concerning treating these diseases found in the specification merely states Applicants' intention to do so. Since no compound has ever been found that can produce an anti-angiogenic effect generally, how is the skilled physician to know what dose to use for each of the different diseases?

c) There is no working example of treatment of any rejected disease in man or animals.

Art Unit: 1624

d) The nature of the invention is clinical treatment of cancers generally, which involves physiological activity.

e) The state of the clinical arts in the cancer treatment related area is extensive with no single report of success of the ability of a single compound to treat cancers generally.

f) The artisan using Applicants invention would be a physician with a MD degree and several years of experience.

g) It is well established that "the scope of enablement varies inversely with the degree of unpredictability of the factors involved", and physiological activity is generally considered to be an unpredictable factor. See *In re Fisher*, 427 F.2d 833, 839, 166 USPQ 18, 24 (CCPA 1970).

h) The scope of the claims involves all of the hundreds of cancers embraced by the claims. Thus, the scope of the claim is very broad. The scope of uses embraced by these claims is not remotely enabled based solely on instant compounds ability to inhibit tyrosine kinase.

MPEP 2164.01(a) states, "A conclusion of lack of enablement means that, based on the evidence regarding each of the above factors, the specification, at the time the application was filed, would not have taught one skilled in the art how to make and/or use the full scope of the claimed invention without undue experimentation. *In re Wright*, 999 F.2d 1557, 1562, 27 USPQ2d 1510, 1513 (Fed. Cir. 1993)." That conclusion is clearly justified here and undue experimentation will be required to practice Applicants' invention.

The how to use portion of the statute has not been addressed. This means that Applicants must teach the skilled practitioner, in this case a physician, how to treat a given subject. The physician clearly must know what diseases and what symptoms are to be treated. In this case, Applicants have not provided what is being treated by claim 10, who the subject is, how one can

Art Unit: 1624

identify said subject (i.e. how one can identify a subject in need), given no specific dose, given no specific dosing regimen, given no specific route of administration, and do not specify what diseases or symptom they intend to treat.

This claim would read on inhibiting Tie2 receptor tyrosine kinase activity in warm-blooded animals with below Tie2 receptor tyrosine kinase activity, Tie2 receptor tyrosine kinase activity inhibition in animals with normal Tie2 receptor tyrosine kinase activity, or in asymptomatic mammals with up-regulated Tie2 receptor tyrosine kinase activity. The specification fails to teach any benefit to be gained from such actions. Is extensive experimentation required on the part of a potential infringer to determine if his use of Applicants' inhibitor falls within the limitations of applicants' claim? *In re Kirk and Petrow*, 153 USPQ 48 (CCPA 1967).

Patent protection is granted in return for an enabling disclosure of an invention, not for vague intimations of general ideas that may or may not be workable. Tossing out the mere germ of an idea does not constitute enabling disclosure. *Genentech Inc. v. Novo Nordisk* 42 USPQ2d 1001.

### ***Double Patenting***

The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the “right to exclude” granted by a patent and to prevent possible harassment by multiple assignees. A nonstatutory obviousness-type double patenting rejection is appropriate where the conflicting claims are not identical, but at least one examined application claim is not patentably distinct from the reference claim(s) because the examined application claim is either anticipated by, or would have been obvious over, the reference claim(s). See, e.g., *In re Berg*, 140 F.3d 1428, 46 USPQ2d 1226 (Fed. Cir. 1998); *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

Art Unit: 1624

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) or 1.321(d) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent either is shown to be commonly owned with this application, or claims an invention made as a result of activities undertaken within the scope of a joint research agreement.

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

Claims 1-5 and 9-11 are provisionally rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims 1-5 and 9-22 of copending Application No. 10/523,401. Although the conflicting claims are not identical, they are not patentably distinct from each other because the claims of copending Application No. 10/523,401 embraces applicants' claimed compounds. The instant claims differ from the claims of copending Application No. 10/523,401 by reciting specific species and a more limited genus than the claims of copending Application No. 10/523,401. However, it would have been obvious to one having ordinary skill in the art at the time of the invention to select any of the species of the genus claimed by copending Application No. 10/523,401, including those instantly claimed, because the skilled chemist would have the reasonable expectation that any of the species of the genus would have similar properties and, thus, the same use as taught for the genus as a whole. One of ordinary skill in the art would have been motivated to select the claimed compounds from the genus in copending Application No. 10/523,401 since such compounds would have been suggested by the reference as a whole. It has been held that a prior art disclosed genus of useful compounds is sufficient to render prima facie obvious a species falling within a genus. *In re Susi*, 440 F.2d 442, 169 USPQ 423, 425 (CCPA 1971), followed by the Federal Circuit in *Merck & Co. v. Biocraft Laboratories*, 847 F.2d 804, 10 USPQ 2d 1843, 1846 (Fed. Cir. 1989).

Art Unit: 1624

This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Bruck Kifle whose telephone number is 571-272-0668. The examiner can normally be reached on Mondays-Fridays from 8:30 AM -6:00 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, James O. Wilson can be reached on 571-272-0661. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Bruck Kifle/  
Primary Examiner  
Art Unit 1624

November 21, 2007